

EXHIBIT 11



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,542- 90/007,859	05/13/2005	6331415	22338-10230	7585

47554 7590 07/19/2008

SIDLEY AUSTIN LLP
ATTN: DC PATENT DOCKETING
1501 K STREET, NW
WASHINGTON, DC 20005

EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED: 07/19/2008

Please find below and/or attached an Office communication concerning this application or proceeding.



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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CHICAGO, IL 60661

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,542.

PATENT NO. 6331415.

90/007,859

ART UNIT 3991.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

#5251

**Ex Parte Reexamination
Advisory Action
Before the Filing of an Appeal Brief**

Control No.

90/007,542

90/007,859

Patent Under Reexamination

6331415

Examiner

BENNETT CELSA

Art Unit

3991

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE PROPOSED RESPONSE FILED 06 June 2008 FAILS TO OVERCOME ALL OF THE REJECTIONS IN THE FINAL REJECTION MAILED 25 February 2008.

1. ☒ Unless a timely appeal is filed, or other appropriate action by the patent owner is taken to overcome all of the outstanding rejection(s), this prosecution of the present *ex parte* reexamination proceeding WILL BE TERMINATED and a Notice of Intent to Issue *Ex Parte* Reexamination Certificate will be mailed in due course. Any finally rejected claims, or claims objected to, will be CANCELLED.
- THE PERIOD FOR RESPONSE IS EXTENDED TO RUN 6 MONTHS FROM THE MAILING DATE OF THE FINAL REJECTION. Extensions of time are governed by 37 CFR 1.550(c).

NOTICE OF APPEAL

2. ☐ An Appeal Brief is due two months from the date of the Notice of Appeal filed on _____ to avoid dismissal of the appeal. See 37 CFR 41.37(a). Extensions of time are governed by 37 CFR 1.550(c). See 37 CFR 41.37(e).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final action, but prior to the date of filing a brief, will not be entered because:
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the proceeding in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____ (See 37 CFR 1.116 and 41.33(a)).


4. ☐ Patent owner's proposed response filed _____ has overcome the following rejection(s): _____
5. ☐ The proposed new or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☐ For purposes of appeal, the proposed amendment(s) a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claim(s) would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) patentable and/or confirmed: _____
- Claim(s) objected to: _____
- Claim(s) rejected: _____
- Claim(s) not subject to reexamination: _____


AFFIDAVIT OR OTHER EVIDENCE

7. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because patent owner failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
8. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence fails to overcome all rejections under appeal and/or appellant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
9. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

10. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
11. ☐ Note the attached Information Disclosure Statement(s), PTO/SB/08, Paper No(s) _____.
12. ☒ Other: Claims 1-36 are rejected.


PADMASHRI PONNALURI
PRIMARY EXAMINER
CRU - AU 3991


Bennett Celsa
Primary Examiner
Art Unit: 3991


DEBORAH D. JONES
CRU SPE-AU 3991

cc: Requester (if third party requester)

U.S. Patent and Trademark Office
PTOL-467 (Rev. 08-06)

Ex Parte Reexamination Advisory Action Before the Filing of an Appeal Brief

Part of Paper No. 2008071038
GENE-CEN 002038

Application/Control Number: 90/007,542; 90/007,859
Art Unit: 3991

Page 2

Advisory Action: Cont.

The February 25, 2008 final rejection of claims 1-36 is hereby maintained.

The After-Final Response dated June 6, 2008 comprising:

- a. An IDS and a Petition to Expunge under Rules 59(b) and MPEP 724.02 and Rule 183 and 550(f) petition to waive 3rd Party Service;
 - b. Declaration of Dr. Walton under 37 CFR 1.132; and
 - c. Second Declaration by Dr. McNight
- is entered.

Petitions To Expunge and Denial of Service

The owner submitted papers deemed confidential and/or proprietary along with a petition for expungement of this material and director waiver of the 37 CFR § 1.550(f) 3rd party service requirement is acknowledged.

Pursuant to MPEP § 724.04 the submitted information is found to be material to the patentability and/or confirmation of the instant reexamination claims. A formal response to the petition will be forthcoming. The patent owner is reminded of the provisions under MPEP 724.04, particularly 724.04 (c), regarding expungement and the treatment of submissions during reexamination.

The Harvard Journal of Law & Technology 17(2)(2004) (pp. 583-618)

The 132 Declaration, by Dr. Walton, a licensing expert, was considered but deemed nonpersuasive for the reasons of record. Particularly, as pointed out in the final office action, the Harvard article provides evidence that one of ordinary skill in the art interpreted the Axel patent claims as being directed to functional proteins, including antibodies. See, Harvard Journal of Law & Technology 17(2) (Spring 2004), pp. 583-618; at pp. 583-590 (background of Axel patent); pp. 591-593 and Appendix A for licensing.

Application/Control Number: 90/007,542; 90/007,859
Art Unit: 3991

Page 3

Dr McNight's Second Declaration:

Dr. McNight's explanation of the deficiencies regarding the Rice, Ochi, Oi, Moore, Kaplan, Dallas, Deacon and Valle1981 references have been previously addressed by the Examiner of record. It is pointed out, that Dr. McNight's analysis fails to appreciate why one of ordinary skill (PhD/MD immunology) in the art exercising their common sense knowledge would be motivated to co-transform and express at least variable regions of heavy and light chains in a single procaryote or eucaryote host cell with a reasonable expectation of success (absolute certainty not required).

Dr. McNight's argument regarding the prosecution history of the Axel patent was not found persuasive. As previously noted, the Axel patent discloses and claims a recombinant method directed to eucaryotic single host production of functional proteins.

Dr Walton's Declaration: Licensing and Commercial Success:

Dr. Walton's declaration evidence of secondary considerations was considered but deemed insufficient to outweigh the *prima facie* case of obviousness double patenting already of record.

Response to Owner's Interview Summary (June 6, 2008 response)

Regarding a possible after-final patent owner submission of an antedating Rule 131 conception/due diligence declaration to overcome prior art reference(s) and Rule 132 declaration (s) to address Examiner-raised issues, the Examiner pointed out that the decision to file, as well as the timing and content of such declarations, was solely the patent owner's decision keeping in mind that such submission(s) would necessarily have to satisfy after-final practice pursuant to MPEP 2272 and 37 CFR 1.116 in order to permit entry at a time in which prosecution is officially closed on the merits.

GENE-CEN 002040

Application/Control Number: 90/007,542; 90/007,859
Art Unit: 3991

Page 4

Future Correspondences

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bennett Celsa whose telephone number is 571-272-0807. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah D. Jones can be reached on 571-272-1535.

Direct correspondences relating to this ex parte reexamination proceeding:

By U.S. Postal Service Mail to:

Mail Stop Ex Parte Reexam ; ATTN: Central Reexamination Unit

Commissioner for Patents; P. O. Box 1450 ; Alexandria VA 22313-1450

By FAX to: (571) 273-9900 ; Central Reexamination Unit

By Hand to: Customer Service Window


Randolph Building, Lobby Level

401 Dulany Street


Alexandria, VA 22314

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Bennett Celsa
Primary Examiner
CRU Art Unit 3991

GENE-CEN 002041

Index of Claims 	Application/Control No. 90007542	Applicant(s)/Patent Under Reexamination 6331415
	Examiner Celsa, Bennett	Art Unit 3991

✓	Rejected	-	Cancelled	N	Non-Elected	A	Appeal
=	Allowed	÷	Restricted	I	Interference	O	Objected

<input type="checkbox"/> Claims renumbered in the same order as presented by applicant				<input type="checkbox"/> CPA		<input type="checkbox"/> T.D.		<input type="checkbox"/> R.1.47	
CLAIM		DATE							
Final	Original	11/19/2007	02/25/2008						
	1	✓	✓						
	2	✓	✓						
	3	✓	✓						
	4	✓	✓						
	5	✓	✓						
	6	✓	✓						
	7	✓	✓						
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	35	✓	✓						
	36	✓	✓						